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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,369	11/26/2003	Atsushi Hirano	1614.1373	1217

79326   7590   09/15/2009
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EXAMINER
MILLER, ALAN S

ART UNIT	PAPER NUMBER
3624	

MAIL DATE	DELIVERY MODE
09/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6 and 8-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6 and 8-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed 6/16/2009, in regards to the application

filed 11/26/2003 claiming benefit back to 11/29/2002.

Claims 1, 3-6, 8-10 and 11-13 are pending and have been examined.

This rejection has been made Non-Final.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 6/16/2009 has been entered.

Response to Arguments

3.   Applicant's arguments filed 6/16/2009 have been fully considered but they are not

persuasive.

Applicant argues, on page 9 of Applicant's remarks, that the due date in Casey-Cholakis

is not the same as '"information related to an end date of a training which is being received by

each worker" because the due date for completion is merely a target date suggested to the user,

while the user will definitely have ended the training by "an end date of a training which is being

received by each worker." Further, Casey-Cholakis et al. merely updates the training history of

the user, and does not store "an end date of a training which is being received by each worker".

The updated training history according to Casey-Cholakis et al. merely indicates which training

has been completed and which training has not been completed', as disclosed in claims 1, 5, 6

and 10. Examiner respectfully disagrees.

The claim broadly states "worker information related to any worker who will have a skill

capable of performing said work item by a time when said work item of the work order is

generated, based on information related to the end date of the training". The claim does not

recite that "the user will definitely have ended the training an end date of a training which is

being received by each worker"; merely that there is an end date. Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the

claims (see *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). All end dates

are target dates, as they are not definite until the date has passed or until the training has been

completed. Further, the claim broadly recites "based on information related to the end date";

Casey-Cholakis discloses a training system that includes a training program listing including a

due date for completion; therefore it discloses information related to an end date for the training.

Further, the training system tracks what training is required for each user and what training has

been completed, and therefore it discloses that the user will have definitely ended the training by

the end date of a training which is being received by the worker, since the training has been

completed.

Response to Amendment

4.   Examiner notes that in reference to the Examiners assertion that "it is old and well known

in the art to store a completion date of training, such as a resume containing a graduation date

(i.e. a completion date) for a degree" in the previous Office Action, the MPEP states "To

adequately traverse such a finding, an applicant must specifically point out the supposed errors in

the examiner's action, which would include stating why the noticed fact is not considered to be

common knowledge or well-known in the art." (See MPEP 2144.03). The MPEP goes on to say

"If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is

not adequate, the examiner should clearly indicate in the next Office action that the common

knowledge or well-known in the art statement is taken to be admitted prior art because applicant

either failed to traverse the examiner's assertion of official notice or that the traverse was

inadequate." Therefore the Applicant has failed to adequately and timely traverse the Examiner's

assertion, and for this reason, to store a completion date of training, such as a resume containing

a graduation date (i.e. a completion date) for a degree, is taken to be admitted prior art.

Claim Objections

5.   Claims **1, 5, 6 and 10** are objected to because of the following informalities: Claims 1, 5,

6 and 10 recite the language "upon no worker information is extractable for a work item".

However, this recitation is grammatically unclear. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

7.   Claims **1, 3-6, 8-10 and 11-13** are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

        Claims 1, 5, 6 and 10 recite the limitation "extracting ... worker information related to a

worker having a skill ... and re-extracting, upon no worker information is extractable for a work

item, worker information related to a worker who will have a skill". However, it is unclear how

information related to any worker is re-extracted, since that information has not been previously

extracted. How can information be re-extracted (i.e. extracted again), when said information has

not been already extracted?   Claims 2-4, 7-9 and 11-13 are rejected as being dependent off of 1,

5, 6 and 10 respectively. Clarification is requested.

                                  Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

        Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
        any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
        requirements of this title.

9.   Claims **1 – 9** are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

        Claims 1- 5 are rejected under 35 U.S.C.101. Based on Supreme Court precedent and

recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must

(1) be tied to a machine or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008);

Diamond v. Diehr, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would <u>not</u> qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, in claims **1** and **5**, applicant's method steps storing, extracting and re-extracting fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. A storage unit can be software, so it does not necessarily qualify as a particular machine. Thus, claims 1 - 5 are non-statutory since they may be performed within the human mind.

Claim **6** is directed towards a work support apparatus comprising units, however units are merely software *per se* and it has been held that software without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101. Claims 7 – 9 are rejected as being dependent from claim 6.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.   Claims **1, 5, 6 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jilk

et al. (U.S. 7,155,400, hereinafter Jilk) in view of Casey-Cholakis et al. (U.S. 6,438,353,

hereinafter Casey-Cholakis).

In respect to claim **1**, Jilk discloses storing skill information of workers in a skill information

storage unit (see column 3, lines 1-10, column 5, lines 37-45, column 6, lines 60-61, and column

11, lines 34-45, which discloses skill information for a worker being stored in a database).

        Jilk does not expressly disclose that an end date associated with a received training is

stored.

        Jilk teaches a task management system that matches employees with tasks based on skills

and certification information, included training information. It is old and well known in the art to

store a completion date of training, such as a resume containing a graduation date (i.e. a

completion date) for a degree. It would have been obvious to one of ordinary skill in the art at the

time of the invention to include in the workers skill information of Jilk, an end date for a

training, since the claimed invention is merely a combination of old elements, and one of

ordinary skill in the art would have recognized that it would produce a predictable result of more

accurately representing that a user has completed a training, thus allowing the system to match only qualified candidates with jobs.

Jilk further discloses storing information of each work item with respect to a work in a work item information storage unit (see column 3, lines 1-10, column 5, lines 49-55, column 7, lines 32-65, and column 16, lines 1-30, which discloses information associated with a work item (task));

storing worker information related to a worker to be registered for each work item in a work information storage unit (see column 3, lines 1-10, column 5, lines 37-55, column 6, lines 60- 61, column 11, lines 18-65, FIG. 4A, and column 15, lines 6-68 through column 16, lines 1-30, wherein worker information that is related to a worker to be registered with tasks is stored);

extracting with respect to each stored work item in response to a work order, worker information related to a worker having a skill capable of performing each work item, based on the skill information of workers stored in the skill information storage unit, (see at least column 2, line 54-column 3, line 10, column 7, lines 32-65, column 15, lines 35- 55 and line 62-column 16, line 29, column 23, lines 40-55, wherein workers are selected for the task based on the skill information stored in the database); and

storing data of the extracted worker with respect to each work item in the work item information storage unit (see at least column 2, line 54-column 3, line 10, column 7, lines 32-65, column 15, lines 35- 55 and line 62-column 16, line 29, column 23, lines 40-55, wherein workers are selected for the task based on the skill information stored in the database).

Jilk further discloses a capacity manager in the task management system that can predict projected workloads and worker demand a period into the future (*i.e. by a time when said work*

item of the work order is generated). The capacity manager also determines training regarding

task skills based on the required task skills and available workers having the required task skills,

and provides said input into a training unit. The capacity manager can also email existing

workers to encourage them to certify in new tasks or can recruit new workers if the projected

worker requirements cannot be met by the current work force. Jilk determines if no worker has

the skills needed, or there are not enough workers with the skills needed for a task, to train or

hire new workers that will have the skill capable of performing the predicted work (*i.e. re-*

extracting worker information related to any worker that will have the skill capable of

performing said work item) (see at least column 9, lines 27-68).

Jilk does not explicitly disclose re-extracting worker information related to a worker that

will have the skill capable of performing said work item based on the information related to the

end date of the training stored in the skill information storage unit.

Casey-Cholakis discloses a training system tracks end of date training and sends emails

when training is required, and stores said information in a database (i.e. *information related to an*

end date of training) (see at least column 4, lines 33-51, wherein Casey-Cholakis discloses a

training system that includes a training program listing including a due date for completion. The

training system tracks what training is required for each user and what training has been

completed, and further sends emails to users when training is required and automatically updates

the user's training history, and storing said information in a database (i.e. *information related to*

an end date of training)).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to include in the capacity manager and training unit of Jilk the training system with due dates,

required training and automatic training history update in a database of Casey-Cholakis since the

claimed invention is merely a combination of old elements, and one of ordinary skill in the art

would have recognized that it would produce a predictable result of having the training

completion and due dates available in a database to determine which workers will have the

required task skills to meet the projected worker requirements by the time they are needed.

Claims **5, 6, and 10** recite substantially similar subject matter to claim 1 and are therefore

rejected using the same art and rationale set forth above.

Claims **3-4, 8-9, and 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Jilk et al. (U.S. 7,155,400, hereinafter Jilk) in view of Casey-Cholakis et al. (U.S.

6,438,353, hereinafter Casey-Cholakis) in further view of Brodersen et al. (U.S. 6,850,895,

hereinafter Brodersen).

As per claim **3**, Jilk et al. teaches wherein said extracting extracts worker information of a

first worker to actually perform each work item and storing extracted workers in the work

information storage section (See column 2, line 54-column 3, line 10, column 7, lines 32-65,

column 15, lines 35-55 and line 62-column 16, line 29, column 23, lines 40-55, wherein workers

are selected for the task based on the skill information stored in the database). However, Jilk et

al. does not expressly disclose that said extracting extracts worker information of a second

worker to assist the first worker.

Brodersen teaches extracting worker information of a second worker to assist the first

worker (see column 2, lines 28-36 and 55-67, column 4, lines 1-5 and 48-67, column 5, lines 42-

60, column 6, lines 27-37, and column 13, lines 10-15, which discloses a rule based system that

matches multiple workers to a task, where one worker is a primary worker).

Both Jilk and Brodersen are concerned with matching workers to jobs based on their skill

sets. Brodersen specifically discloses assigning multiple workers to the same task, with one

worker being the primary worker. It would have been obvious to one of ordinary skill in the art

at the time of the invention to include selecting a second worker for a task in order to more

efficiently work on complex tasks using a team of workers (see Brodersen, column 2, lines 28-

36).

As per claim **4**, Jilk et al. teaches wherein said extracting extracts the worker information

of the worker for the work item based on the work having skills comparable to that required of

the work item, by referring to the skill information storage section (See column 2, line 54-

column 3, line 10, column 7, lines 32-65, column 15, lines 35-55 and line 62-column 16, line 29,

column 23, lines 40-55, wherein workers are selected for the task based on the skill information

stored in the database). However, Jilk et al. does not expressly disclose extracting worker

information of a second worker to assist the first worker, where the second worker has a skill

comparable to that of the first worker.

Brodersen discloses extracting worker information of a second worker to assist the first

worker, where the second worker has a skill comparable to that of the first worker (See column

2, lines 28-36 and 55-67, column 4, lines 1-5 and 48-67, column 5, lines 42-60, column 6, lines

27-37, and column 13, lines 10-15, which discloses a rule based system that matches multiple

workers to a task, where one worker is a primary worker. Both workers have skills that match the

job profile, and thus the second worker has a skill comparable to that of the first worker).

Both Jilk et al. and Brodersen are concerned with matching workers to jobs based on their

skill sets. Brodersen specifically discloses assigning multiple workers to the same task, with one

worker being the primary worker. It would have been obvious to one of ordinary skill in the art

at the time of the invention to include selecting a second worker for a task in order to more

efficiently work on complex tasks using a team of workers (see Brodersen, column 2, lines 28-

36).

Claims **8 and 9** recite substantially similar subject matter to claims 3 and 4, respectively,

and are therefore rejected using the same art and rationale set forth above.

Claims **12 and 13** recite substantially similar subject matter to claims 3 and 4,

respectively, and are therefore rejected using the same art and rationale set forth above.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

a.   Lane (U.S. 2003/0130820) teaches technician skills and comparison to previous

work orders to benchmark skill needs.

b.   Sinex (U.S. 2002/0133389) teaches training records and selecting the most skilled

technicians to perform maintenance.

c.   Hadden et al. (U.S. 7,181,413) teaches knowledge and skill levels assessment of

employees, looking at skill levels before and after training.

d.   McGovern et al. (U.S. 5,918,207) discloses assessing the skill levels of employees

and determining and implementing development plans and training.

e.   Kramer et al. (U.S. 2002/0052773) discloses determining the skill rating of a

worker and then planning training.

f.   Sisley et al. (U.S. 5,737,728) discloses assigning employees based on the

employees skill sets and the needs of the jobs.

g.   Lesaint et al. (U.S. 6,578,005) teaches allocating resources (i.e. employees) to

tasks based on the assignment rules and the skills of a resource.

h.   Travis et al. (U.S. 2004/0088177) teaches assessing employee skills and job

requirements and then determining and managing training for employees.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ALAN MILLER whose telephone number is (571)270-5288.

The examiner can normally be reached on Mon - Fri, 10:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, BRADLEY BAYAT can be reached on (571) 272-6704. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. M./
Examiner, Art Unit 3624

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624